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Response to 06-16-2008 Office action

Date of deposit: September 15, 2008

Remarks

Applicant acknowledges with appreciation the following withdrawals of rejections under 35 U.S.C. §103(a):

claims 73-83, 85-91, 107-110 and 112 in view of Checco (U.S. patent number 5,859,898) in combination with Lovett (U.S. patent number 4,450,477) and Schussler et al. (U.S. patent number 4,150,254);

claim 92 in view of Checco (U.S. patent number 5,859,898) in combination with Lovett (U.S. patent number 4,450,477) and Schussler et al. (U.S. patent number 4,150,254), the primary references analyzed above, and further in combination with Wagner et al. (U.S. patent number 6,335,736);

claims 93, 99, and 129-130 in view of Krisbergh et al. (U.S. patent number 5,138,649) in combination with Krisbergh et al. (U.S. patent number 5,999,970);

and, claims 94-98, 100, and 131 in view of Krisbergh '970 in combination with Krisbergh '649 and Krueger et al. (U.S. patent number 6,460,075).

Upon entry of this Response, claims 73-83, 85-100, 107-110, 112, and 129-131 are pending.

Claims 73-83, 85-91, 107-110, 112, and 129-131 comply with 35 U.S.C. §103(a)

In discussing the rejections under 35 U.S.C. §103(a) of claims in this case, Applicant refers to the *Manual of Patent Examining Procedure* (M.P.E.P.) §2141, which states that when applying 35 U.S.C. §103 four tenets of patent law must be adhered to:

(A) The claimed invention must be considered as a whole;

(B) The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;

(C) The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and

(D) Reasonable expectation of success is the standard with which obviousness is determined. M.P.E.P., §2141, p. 125 (8th Ed. Rev.3, August, 2005); *Hodosh v. Block Drug Co., Inc.*, 786 F.2d 1136, 1143 n.5, 229 USPQ 182, 187 n.5 (Fed. Cir. 1986). [emphases added]

Claims 73-83, 85-91, 107-110 and 112 comply with 35 U.S.C. §103(a)

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The Office action on p. 6 rejects claims 73-83, 85-91, 107-110 and 112 under 35 U.S.C. §103(a) in view of Checco (U.S. patent number 5,859,898) in combination with Lovett (U.S. patent number 4,450,477) and Sizer et al. (U.S. patent number 6,021,324). Applicant respectfully traverses.

For the convenience of the reader prior to analyzing the cited references, Applicant here reviews the subject matter of independent claims 73 and 107.

Claim 73 is directed *inter alia* to a television messaging gateway for handling messages, adapted for operating in conjunction with a television distribution system connected to a video downstream network constructed to carry video signals to a plurality of end terminals, wherein at least one terminal is constructed to selectively display said video signal on a television screen, the television messaging gateway having: a message control interface adapted to couple to a messaging server to control at least one message having address information associating the message with at least one user, a video output module capable of generating video frame signals corresponding to said message server and being adapted to couple to a downstream network for outputting video frame signals on a television coupled to an addressable terminal, an input interface adapted to connect to an upstream network for receiving user input signals inputted using a telephone and logic for directing said message between the message control interface and a video output module.

Claim 107 is directed *inter alia* to a method for handling messages, that involves using a telephone to input commands to a television messaging gateway to select at least one message directed to a user causing the television messaging gateway to output messages via a television distribution system to a television set associated with the user.

In other words claims 73 and 107 as a whole are directed to an invention that allows a subscriber to use a telephone to control and view messages on a television set.

As a preliminary matter, the Supreme Court in *Graham v. John Deere*, 383 U.S. 1 provided an analytical construct to be used when determining whether claims are obvious under 35 U.S.C. §103(a) in view of the prior art. One aspect of this analytical construct includes characterizing each cited reference, as a background for a legal analysis, prior to analyzing the combination of the references.

Checco (U.S. patent number 5,859,898, issued January 12, 1999)

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Checco shows a message system that includes voice or data messages that are left by a user who does not have to be a subscriber and retrieved at the convenience of the recipient. *Checco*, Abstract, lines 1-3, column 8, line 58. A subscriber may connect to the system using a telephone, a computer, a fax machine or a set-top box connected to a television or monitor, preferably accessing the system at a single entry point. *Checco*, column 4, lines 24-33. The system preferably requests a user id and password and determines whether the user is a subscriber or a secondary user. The subscriber gets a customer menu and the secondary user gets restricted access according to the user id. *Checco*, column 7, lines 19-22 & 30-36. The user providing no user id or password is restricted to uploading messages for the subscribers. *Ibid* lines 45-47. To leave a message the user issues a request to the system and inputs the message using a calling device. The message is processed by the PARS and forwarded to the data message storage. *Checco*, column 8, lines 57-67 thru column 9, lines 1-28. To retrieve a message the subscriber selects a message from the menu on the calling device, the message is retrieved from the data message store, converted to the appropriate format by PARS and delivered to the calling device. *Checco*, column 10, lines 49-61.

Thus, *Checco* evaluated as a whole describes a system that accepts requests to leave messages using multiple calling devices and data formats, and displays stored messages on multiple subscriber calling devices. The system restricts user access to content with user id and password combinations.

The Office action admits on page 4 that *Checco* does not explicitly show a video downstream network.

Nowhere does *Checco* teach or suggest a messaging control interface for controlling at least one message having address information associating the message with at least one user, a video output module adapted to couple to a downstream network for outputting video frame signals on a television coupled to an addressable terminal with an input interface adapted to connect to an upstream network for receiving user input signals inputted using a telephone and logic for directing a message between a message control interface and a video output module, to which claim 73 is *inter alia* directed. That is, nowhere does *Checco* teach or suggest a system for a person sitting and watching television to automatically receive an email or a telephone call on the television, in real time.

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Nowhere does Checco teach or suggest a method for handling messages using a telephone, inputting commands to a television messaging gateway, to select at least one message directed to a user, causing messages or a message to be outputted to a television set associated with the user, to which claim 107 is *inter alia* directed.

In other words, nowhere does Checco teach or suggest a system with which a user can use a telephone to send an email, video or other message to a particular addressed terminal for display on a television.

Lovett (U.S. patent number 4,450,477, issued May 22, 1984)

Lovett shows a system that delivers selected information from data banks to individual cable television subscribers through the same system that brings them television programming and that can be displayed on unmodified television sets. Lovett, column 6, lines 26-36.

Lovett's system converts the digital information selected from the databank by the individual user to analog form and transmits that information on a unique frequency corresponding to the particular subscriber's television set. Ibid, column 7, lines 61-66. Lovett shows a system in which the subscriber receives the selected information "[o]nly when the subscriber's television set is tuned to his dedicated UHF information channel." Lovett, column 14, lines 12-14 [emphasis added].

Lovett states as an objects of his system that individual subscribers are able to receive selected information from data banks on their own, unmodified television sets without the need for expensive terminal equipment at the subscribers' locations and that the system maintains privacy by giving each subscriber a dedicated television channel." Lovett, column 6, lines 29-42.

Thus, Lovett's system evaluated as a whole shows the use of a unique UHF frequency for each subscriber as the operating principle by which the system supplies individualized content to subscribers.

Nowhere does Lovett teach or suggest a messaging control interface for controlling at least one message having address information associating the message with at least one user, a video output module adapted to couple to a downstream network for outputting video frame signals on a television coupled to an addressable terminal with an input interface adapted to connect to an upstream network for receiving user input signals inputted using a telephone and logic for directing a message between a message control interface and a video output module, to

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which claim 73 is *inter alia* directed. That is, nowhere does Lovett teach or suggest a system for a person sitting and watching television to automatically receive an email or a telephone call on the television, in real time.

Nowhere does Lovett teach or suggest a method for handling messages using a telephone, inputting commands to a television messaging gateway, to select at least one message directed to a user, causing messages or a message to be outputted to a television set associated with the user, to which claim 107 is *inter alia* directed. In other words, nowhere does Lovett teach or suggest a system with which a user can use a telephone to send an email, video or other message to a particular addressed terminal for display on a television.

Sizer et al. (US patent number 6,021,324, issued February 1, 2000)

Sizer et al. taken as a whole shows control of premises appliances and reception, storage and retrieval of telephone information via a premises recording unit (Sizer et al., column 1, lines 59-64). This recording unit communicates with household appliances via a wireless packet transmitter which generates a radio, infrared or ultrasonic signal (Ibid., column 2, lines 17-23). Sizer describes "a premises" as a home or office (Ibid., column 1, lines 60-61). A television set connected to the recording unit via a video interface connector port is used to display information stored on the recording unit (Ibid., column 4, lines 44-49).

In Sizer, a premises recording unit answers a phone call from a user and prompts the user for a preprogrammed DTMF (dual tone multi-frequency) sequence (Ibid., column 7, lines 22-27). Based on the preprogrammed DTMF sequence the user activates a signal packet transmitter which sends a packet signal to an appliance controller for a coffee maker or other appliance (Ibid., column 7, lines 26-27). The packet signal includes an address portion which signifies that the coffee maker controller is the proper recipient of the signal packet and a data portion which signifies the desired instructions such as allowing electric current to flow to the coffee maker (Ibid., column 7, lines 28-33). In one example, Sizer shows the packet transmitter operating on a radio frequency between 2.45 GHz to 6.0 GHz on an antenna attached directly to the circuit board. Ibid., column 7, lines 55-60. The appliance controller can also include a transmitter for transmitting feedback information to the premises recording unit, thus forming a closed loop control system. Ibid, column 8, lines 5-8.

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In summary, Sizer's system evaluated as a whole shows a home or office automation system which utilizes recorded telephone information to control an appliance such as a coffee pot by wireless transmission over a single channel.

Nowhere does Sizer show any of a television messaging gateway, a plurality of terminals, a video downstream network, a video upstream network, or a distributed television messaging gateway, having a message control interface for selecting at least one message from a unified messaging server.

Legal Analysis

The ultimate determination of whether an invention would have been obvious under 35 U.S.C. §103(a) is a legal conclusion based on underlying findings of fact. *In re Kotzab*, 217 F.3d 1365, 1369 (Fed. Cir. 2000).

According to a summary of criteria in the M.P.E.P., "[t]o establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." [emphasis added] M.P.E.P. §2142; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

A recent decision by the U.S. Supreme Court, *KSR International Co. v. Teleflex Inc.* 550 U.S. ____ (2007), discusses criteria for showing a motivation to combine numerous prior art references in a determination that a claimed invention is obvious. The U.S. Supreme Court in *KSR* explained that "[t]here is no necessary inconsistency between the idea underlying the TSM [teaching, success, motivation] test and the *Graham* analysis." *KSR International Co.* 550 U.S. ____ at p. 15. In fact, the court explains "... it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the newly claimed invention does." *Id.*

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This interpretation of *KSR International Co. v. Teleflex Inc.* is confirmed by Guidelines promulgated by the U.S. Patent and Trademark Office and published October 10, 2007 in the Federal Register (vol. 72, no. 195, pp. 57526-57535).

Applicant respectfully traverses the above rejection, and shows below that the facts of the case and the relevant case law indicate that the invention would not have been obvious to one of ordinary skill in the art at the time the application was filed because the underlying facts show that the criteria for a *prima facie* rejection have not been met.

Prior art fails to teach all the subject matter of the claims

As shown above, the M.P.E.P. states that to establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all the subject matter of the claim.

Checco as a whole describes a system accepts requests from multiple devices and data formats and restricts user access to content with user id and password combinations.

Nowhere does Checco teach or suggest a messaging control interface for controlling at least one message having address information associating the message with at least one user, a video output module adapted to couple to a downstream network for outputting video frame signals on a television coupled to an addressable terminal with an input interface adapted to connect to an upstream network for receiving user input signals inputted using a telephone and logic for directing a message between a message control interface and a video output module, to which claim 73 is *inter alia* directed.

Nowhere does Checco teach or suggest a method for handling messages using a telephone, inputting commands to a television messaging gateway, to select at least one message directed to a user, causing messages or a message to be outputted to a television set associated with the user, to which claim 107 is *inter alia* directed.

Lovett shows a system that delivers selected information from data banks to individual cable television subscribers through the same system that brings them television programming and that is displayed on unmodified television sets. Lovett, column 6, lines 26-36.

Nowhere does Lovett teach or suggest a messaging control interface for controlling at least one message having address information associating the message with at least one user, a video output module adapted to couple to a downstream network for outputting video frame

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signals on a television coupled to an addressable terminal with an input interface adapted to connect to an upstream network for receiving user input signals inputted using a telephone and logic for directing a message between a message control interface and a video output module, to which claim 73 is *inter alia* directed.

Nowhere does Lovett teach or suggest a method for handling messages using a telephone, inputting commands to a television messaging gateway, to select at least one message directed to a user, causing messages or a message to be outputted to a television set associated with the user, to which claim 107 is *inter alia* directed.

Nowhere does Sizer teach or suggest a messaging control interface for controlling at least one message having address information associating the message with at least one user, a video output module adapted to couple to a downstream network for outputting video frame signals on a television coupled to an addressable terminal with an input interface adapted to connect to an upstream network for receiving user input signals inputted using a telephone and logic for directing a message between a message control interface and a video output module, to which claim 73 is *inter alia* directed.

Nowhere does Sizer teach or suggest a plurality of terminals to which claim 73 is *inter alia* directed.

Nowhere does Sizer teach or suggest a television messaging gateway for outputting a selected message via a television distribution system to which claim 107 is *inter alia* directed..

Nowhere does Sizer teach or suggest a messaging control interface for controlling at least one message having address information associating the message with at least one user, a video output module adapted to couple to a downstream network for outputting video frame signals on a television coupled to an addressable terminal with an input interface adapted to connect to an upstream network for receiving user input signals inputted using a telephone and logic for directing a message between a message control interface and a video output module, to which claim 73 is *inter alia* directed.

Most important, neither Lovett nor Sizer cures the defects of Chccco. Therefore, the combination of Chccco, Lovett, and Sizer fails to render obvious the subject matter of claims 73 and 107 because the prior art references when combined do not teach or suggest all of the subject matter of the claims, as required by M.P.E.P. §2142. Therefore a *prima facie* case of obviousness has not been made.

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Claims 74-83 and 85-91 depend from claim 73, and incorporate all of the subject matter of claim 73 and contain additional subject matter. As the combination of Checco, Lovett, and Sizer fails to render obvious the subject matter of claim 73, therefore claims 74-83 and 85-91 also are not obvious in view of Checco, Lovett, and Sizer, alone or in any combination.

Claims 108, 110, and 112 depend from claim 107, and incorporate all of the subject matter of claim 73 and contain additional subject matter. As the combination of Checco, Lovett, and Sizer fails to render obvious the subject matter of claim 107, therefore claims 108, 110, and 112 also are not obvious in view of Checco, Lovett, and Sizer, alone or in any combination.

Claim 109 depends from claim 108 and indirectly from claim 107, and incorporates all of the subject matter of claim 107 and contains additional subject matter. As the combination of Checco, Lovett, and Sizer fails to render obvious the subject matter of claim 107, therefore claim 109 also is not obvious in view of Checco, Lovett, and Sizer, alone or in combination.

Therefore for these reasons Applicant respectfully requests withdrawal of rejection of claims 73-83, 85-91, 107-110 and 112 under 35 U.S.C. §103(a).

No motivation to combine references having different principles of operation

To establish that a claim does not comply with 35 U.S.C. §103(a) based on a combination of the elements disclosed in the prior art in the absence of any hindsight, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. M.P.E.P., §2143.01, p. 135; *In re Fulton*, 391 F.3d at 1200-01, 73 USPQ2d at 1145-46 (Fed. Cir. 2004). The teaching or suggestion, not merely to make the claimed combination, but also of a reasonable expectation of success, must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488; 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

The U.S. Supreme Court in *KSR International Co. v. Teleflex Inc.* affirmed the legal principle that the mere fact that each element of a claimed invention could be found within the prior art does not render the claimed invention obvious. The court stated:

.... A patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art. *KSR International Co.* 550 U.S. ____ at p. 14

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The M.P.E.P. states "[I]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." M.P.E.P. §2143.01, p. 138; *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

In *In re Ratti*, 270 F.2d 810 (CCPA 1959), claims were directed to an oil seal having a bore engaging portion with outwardly biased resilient spring fingers inserted in a resilient sealing member. The primary reference relied upon in a rejection based on a combination of references showed an oil seal in which the bore engaging portion was reinforced by a cylindrical sheet metal casing. The prior art device required rigidity for operation, whereas the claimed invention required resiliency. The court reversed the rejection holding that the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate." See M.P.E.P. §2143.01 citing *In re Ratti* 270 F.2d at 813.

Applicant shows below that there would have been no motivation to have combined Checco and Lovett to arrive at the subject matter of the present claims at the time the invention was made, because such a combination would have required a change in the principle of operation of Lovett.

Lovett's cable television customers are assigned unique UHF television frequencies as a means of offering individualized content to each subscriber. Lovett column 7, lines 61-66. Factual analysis above demonstrates that Lovett's method requires a unique frequency for each subscriber.

Factual analysis further demonstrates that Checco does not operate by assigning users unique UHF frequencies. Instead of unique UHF frequencies, Checco restricts user access to messages and other data by requiring user logins and passwords such that data is not available to all users. Checco column 7, lines 35-41.

As in *In re Ratti* in which the prior art required rigidity whereas the claimed invention required resiliency, Lovett describes a system that uses a unique UHF frequency television signal, whereas Checco's system accepts multiple data formats and limits access with login and password combinations. To have combined these two references would have required a suggestion to eliminate Lovett's assigning a user a unique UHF frequency, which is the central principle of operation in Lovett. To have combined Checco with Lovett would have required a

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change to Lovett's principle of operation and instead to have assigned content by user login. Therefore, there would have been no motivation to have combined these references at the time the present invention was made, as such a combination would have required a change in the principle of operation of Lovett or Checco.

The examiner on Page 4 alleges:

Requiring user ID & password, as taught by Checco, merely provides an additional layer of security, added to Lovett. Because, even though only a particular subscriber terminal at a particular household would receive the requested data as in Lovett, one of ordinary skill in the art would have readily recognized the benefit of requiring a user ID & password, which insures that only the member(s) of the household that is authorized to view the instant requested data, would be able to view the instant data.

Lovett states in his Abstract "Privacy is assured by dedicating to each subscriber a different carrier frequency and associated television channel, and by filtering out all other channels which might be transmitted on the feeder line." [emphasis added] Therefore, provision of privacy by a dedicated carrier frequency is clearly and unambiguously a principle of operation of Lovett's system. Lovett further states;

Using the present invention, individual subscribers are able to receive selected information from the data banks through the same system which brings them television programming, and to receive it on their own, unmodified television sets. Accordingly, another object is to provide information to subscribers without the need for expensive terminal equipment at the subscribers' locations.

... Another object is to maintain privacy in an information retrieval system by giving each subscriber a dedicated television channel;..." Lovett, column 6, lines 29-42; emphases added.

As Lovett expressly states that providing information to subscribers without the need for expensive terminal equipment is an object of his system, the use of a user ID and password which would have required such terminal equipment would have changed the principle of operation of Lovett. To suggest otherwise is a mischaracterization Lovett.

The combination of Checco, Lovett, and Sizcr fails to render obvious the subject matter of claims 73 and 107 because the proposed modification or combination of the prior art would have changed the principle of operation of Lovett's method. M.P.E.P. §2143.01, p. 138; In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Therefore for this reason also, a *prima facie* case of obviousness has not been made.

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Claims 74-83 and 85-91 depend from claim 73, and incorporate all of the subject matter of claim 73 and contain additional subject matter. As the combination of Checco, Lovett, and Sizer fails to render obvious the subject matter of claim 73, therefore claims 74-83 and 85-91 also are not obvious in view of Checco, Lovett, and Sizer, alone or in combination.

Claims 108, 110, and 112 depend from claim 107, and incorporate all of the subject matter of claim 73 and contain additional subject matter. As the combination of Checco, Lovett, and Sizer fails to render obvious the subject matter of claim 107, therefore claims 108, 110, and 112 also are not obvious in view of Checco, Lovett, and Sizer, alone or in combination.

Claim 109 depends from claim 108 and indirectly from claim 107, and incorporates all of the subject matter of claim 107 and contains additional subject matter. As the combination of Checco, Lovett, and Sizer fails to render obvious the subject matter of claim 107, therefore claim 109 also is not obvious in view of Checco, Lovett, and Sizer, alone or in combination.

For any of the above reasons, Applicant respectfully requests withdrawal of rejection of claims 73-92 and 107-112 under 35 U.S.C. §103(a).

Claim 92 complies with 35 U.S.C. §103(a)

The Office action on p. 11, paragraph 4, rejects claim 92 under 35 U.S.C. §103(a) in view of Checco (U.S. patent number 5,859,898) in combination with Lovett (U.S. patent number 4,450,477) and Sizer et al. (U.S. patent number 6,021,324), the primary references analyzed above, and further in combination with Wagner et al. (U.S. patent number 6,335,736). Applicant respectfully traverses.

For the convenience of the reader prior to analyzing the additional reference, Applicant here reviews the subject matter of independent claim 92.

Claim 92 is directed *inter alia* to the television messaging gateway of claim 73, and is further adapted to generate signals to display on a television screen a progress bar indicating relative progress of an audio or video message being delivered to a terminal. Thus, claim 92 depends from and incorporates all of the subject matter of claim 73 and contains additional subject matter.

Checco, Lovett, and Sizer are characterized above.

Wagner et al. (U.S. patent number 6,335,736, issued January 1, 2002)

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Wagner as a whole, shows a graphical user interface (GUI) for a television set-top box which includes a web browser. See Wagner Abstract. The GUI generates menu screens that are superimposed over conventional television video images, so that the user can view browser graphics generated by the GUI while viewing television images in the background. Ibid. Wagner shows an interface that provides animated on-screen notifications of the presence of interactive content, such as hypertext links to World Wide Web pages, that may be associated with television content currently being received. Ibid. Wagner specifics, "[a]s will be described below, the GUI includes features which provide relatively seamless transitions between viewing television and interactive content, and which enhance the overall viewing experience." [emphases added] Ibid., column 3, lines 14-18.

Nowhere does Wagner teach or suggest a messaging control interface for controlling at least one message having address information associating the message with at least one user, a video output module adapted to couple to a downstream network for outputting video frame signals on a television coupled to an addressable terminal with an input interface adapted to connect to an upstream network for receiving user input signals inputted using a telephone and logic for directing a message between a message control interface and a video output module, to which claim 73 is *inter alia* directed. In other words, nowhere does Wagner teach or suggest a system in which a person can use a telephone to control a message and send it to a particular addressed television, in real time, if the system of these claims is turned on.

The combination of Checco, Lovett, and Sizer fails to render obvious the subject matter of claim 73 because the combination of prior art references does not teach or suggest all of the subject matter of the claims, as required by M.P.E.P. §2142. Claim 92 depends from claim 73, and incorporates all of the subject matter of claim 73 and contains additional subject matter. Wagner does not cure any of the deficiencies of Checco in combination with Lovett and Sizer. Therefore a *prima facie* case of obviousness has not been made.

As the combination of Checco, Lovett, and Sizer fails to render obvious the subject matter of claim 73, therefore claim 92 also is not obvious in view of Checco, Lovett, Sizer, and Wagner alone or in any combination.

For any of the above reasons, Applicant respectfully requests withdrawal of rejection of claim 92 under 35 U.S.C. §103(a).

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Claims 93, 99, and 129-130 comply with 35 U.S.C. §103(a)

The Office action on page 12, paragraph 5 rejects claims 93, 99, and 129-130 under 35 U.S.C. §103(a) in view of Sizer et al. (U.S. patent number 6,021,324) in combination with Krisbergh et al. (U.S. patent number 5,999,970, hereinafter Krisbergh). Applicant respectfully traverses the rejection.

For the convenience of the reader prior to analyzing the cited references, Applicant here reviews the subject matter of present pending independent claims 93 and 129.

Claim 93 herein is directed *inter alia* to a television messaging gateway for handling messages, operating in conjunction with a television distribution system having a downstream network carrying signals to a plurality of terminals, an upstream network constructed to deliver user input signals, the television gateway comprising a message control interface responsive to input signals for controlling at least one message having address information to associate the message with at least one user and an output module adapted to generating video frame signals corresponding to the message and constructed to deliver the signal to a terminal corresponding to the address information for display on a television set coupled thereto wherein the message control interface is constructed to control the message responsive to user input signals entered via telephone. That is, claim 93 is directed to a television messaging gateway with which a user can use a telephone to send an email, video or other addressed message to a particular addressed terminal for display on a television.

Claim 129 is directed *inter alia* to a system for handling messages, operating in conjunction with a television distribution system having a downstream network carrying signals to a plurality of terminals, an upstream network constructed to deliver user input signals, the television gateway comprising a message control interface responsive to input signals for controlling at least one message having address information to associate the message with at least one user and an output module adapted to generating video frame signals corresponding to the message and constructed to deliver the signal to a terminal corresponding to the address information for display on a television set coupled thereto wherein the message control interface is constructed to control the message responsive to user input signals entered via telephone. That is, claim 129 is directed to a system with which a user can use a telephone to send an email, video or other addressed message to a particular addressed terminal for display on a television.

Below, Applicant characterizes the cited references as a background for a legal analysis.

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Krisbergh et al. (U.S. patent number 5,999,970, issued December 7, 1999)

Krisbergh shows an access system and method for providing interactive access to an information source through a television distribution system. Krisbergh Abstract. Access to the internet is provided through a cable television distribution system in Krisberg. Ibid., column 1, lines 10-12.

Krisbergh shows a system in which all terminals on the downstream channel receive all downstream packets. A particular terminal ignores the contents of the downstream packet if the packet's session ID does not correspond to the session ID of the terminal. Krisbergh column 10, lines 18-23. If a terminal wishes to initiate a session on the access system, the terminal must listen on the downstream channel for a housekeeping packet, and upon receipt of the housekeeping packet can determine what upstream channels are associated with the downstream channel. Ibid., Column 10, lines 31-36. The terminal can then send a session request on one of the upstream channels associated with the downstream channel to which it is assigned. Ibid., column 10, lines 36-38.

Krisbergh et al. shows an access system and a method for providing an interactive access system to an information source such as the internet, E-mail interchange, a "chat room" interchange, the application server itself, or the like through a television distribution system which includes a television distribution network, headend distribution equipment, and a plurality of terminals. Krisbergh et al., column 1, lines 46-50 & column 4, lines 62-65. Commands are input to the information source using a keyboard associated with one of the terminals or a remote control. Ibid., column 8, lines 34-55. Requested information is sent from the information source over the respective downstream channels of the television distribution network via a plurality of set top converters being interfaced to a terminal end. Ibid., column 4, lines 3-8 & 30-37.

Thus, Krisbergh evaluated as a whole shows a system in which all terminals on the downstream channel receive all downstream packets and and communicate requests to the video server using upstream channels that are separate and distinct from the downstream channel.

Nowhere does Krisbergh teach or suggest a television gateway comprising a message control interface responsive to input signals for controlling at least one message having address information to associate the message with at least one user and an output module adapted to generating video frame signals corresponding to the message and constructed to deliver the

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signal to a terminal corresponding to the address information for display on a television set to which claims 93 and 129 are *inter alia* directed.

Nowhere does Krisbergh teach or suggest a message control interface constructed to control a message responsive to user input signals entered via a telephone to which claim claims 93 and 129 are directed *inter alia*.

Nowhere does Krisbergh teach or suggest a distributed television messaging gateway to which claim 129 is *inter alia* directed.

In other words, Krisberg fails to teach or suggest a system with which a user uses a telephone to select or otherwise control a message for display on a television associated with a terminal with a particular address.

Sizer is characterized above.

Legal Analysis

Prior art must teach all subject matter of the claims

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all the subject matter of the claim. M.P.E.P. §2142; *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicant shows below that the combination of Sizer and Krisbergh does not teach or suggest all the subject matter of independent claims 93 and 129.

Legal analysis of the combination of references

Sizer shows a home automation system wherein a user can input predetermined codes by telephone to control appliances such as a coffee pot and for which caller id information is displayed to a television connected to a premises recording device.

Nowhere does Sizer teach or suggest a television messaging gateway adapted to operate in conjunction with a television distribution system having a downstream network constructed to carry and distribute signals to a plurality of terminals and which operates in conjunction with an upstream network to which claim 93 is *inter alia* directed.

Nowhere does Sizer teach or suggest a distributed television messaging gateway to which claim 129 is *inter alia* directed.

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Krisbergh shows a system in which all terminals on the downstream channel receive all downstream packets and a particular terminal will ignore the contents of the downstream packet if the packet's session ID does not correspond to the session ID of the terminal. Krisbergh column 10, lines 18-23.

Krisbergh's system shows a headend server acting as a centralized processor for each of plurality of terminals where terminals may communicate with each other by sending a message on the upstream network to the central server, which then sends the message on the downstream network for reception by the intended terminal. Krisbergh column 9, lines 19-26.

Nowhere does Krisbergh teach or suggest a distributed television messaging gateway to which claim 129 is *inter alia* directed.

Nowhere does Krisbergh teach or suggest a television gateway comprising a message control interface responsive to input signals for controlling at least one message having address information to associate the message with at least one user and an output module adapted to generating video frame signals corresponding to the message and constructed to deliver the signal to a terminal corresponding to the address information for display on a television set to which claims 93 and 129 are *inter alia* directed.

Nowhere does Krisbergh teach or suggest a message control interface constructed to control a message responsive to user input signals entered via a telephone to which claims 93 and 129 are directed *inter alia*.

In other words, neither Sizer nor Krisberg teach or suggest a system by which a user can use a telephone to select or otherwise control a message for display on a television associated with a terminal with a particular address.

The combination of Sizer and Krisberg fails to render obvious the subject matter of claims 93 and 129 because these references when combined do not teach or suggest all of the subject matter of the claims, as required by M.P.E.P. §2142. Therefore a *prima facie* case of obviousness has not been made.

Claims 99 and 130 depend from claim 93 and 129 respectively and incorporate all of the subject matter of claim 93 and 129 respectively and contain additional subject matter. As the combination of Sizer and Krisbergh fails to render obvious the subject matter of claims 93 and 129, therefore claims 99 and 130 also are not obvious in view of Sizer and Krisbergh, alone or in combination.

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Applicant respectfully requests withdrawal of rejection of claims 93, 99, and 129-130 under 35 U.S.C. §103(a).

Legal Analysis of motivation to combine the references

It is well established that a proposed modification or combination of prior art references which would change the principle of operation of the prior art invention being modified is not sufficient to render the claims *prima facie* obvious. M.P.E.P., §2143.01, p. 138; *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

Applicant shows below that there would have been no motivation to have combined Sizer and Krisberg to have arrived at the subject matter of the present claims at the time the present application was filed, because such a combination would have required a change in the principle of operation of Sizer or that of Krisberg.

According to the factual analysis above, Sizer is a system in which a premises recorder is connected to telephone lines on one or more channel. But, communication between the premises recorder and the devices it controls, such as a coffee pot or a television, takes place wirelessly on a single channel. Thus, the principle of operation for communication with devices in Sizer is that of single channel wireless communication.

Factual analysis above further shows that Krisbergh is a system which uses a cable television format for data transmission which requires upstream and downstream channels. In other words, Krisberg shows a system in which a terminal or other device receives data on one frequency, the downstream channel, and then waits for a housekeeping packet to determine which upstream channels (or frequencies) it may use for data it sends back to the server. Thus the principle of operation for communication with terminals in Krisberg is that of multiple, upstream and downstream channels.

As in *In re Ratti* where the prior art required rigidity whereas the claimed invention required resiliency, server to terminal communications in Krisberg require separate upstream and downstream channels whereas premises recorder to device communications in Sizer require a single wireless channel. To have combined Sizer with Krisberg would have required abandoning the principle of operation for communications in Krisberg. Therefore, there would have been no motivation to have combined these references as such a combination would have required a change in the principle of operation of either Sizer's or Krisberg's system.

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The combination of Sizer and Krisberg fails to render obvious the subject matter of claims 93 and 129 because combining the prior art would have required changing the principle of operation of the systems in these references.

Claims 99 and 130 depend from claim 93 and 129 respectively and incorporate all of the subject matter of claim 93 and 129 respectively and contain additional subject matter. As the combination of Sizer and Krisbergh fails to render obvious the subject matter of claims 93 and 129, therefore claims 99 and 130 also are not obvious in view of Sizer and Krisbergh, alone or in combination.

Applicant respectfully requests withdrawal of rejection of claims 93, 99, and 129-130 under 35 U.S.C. §103(a) in view of Sizer and Krisberg.

Claims 94-98, 100, and 131 comply with 35 U.S.C. §103(a)

The Office action on page 14, paragraph 6 rejects claims 94-98, 100, and 131 under 35 U.S.C. §103(a) in view of Krisbergh in combination with Sizer and Krueger et al., U.S. patent number 6,460,075.

Applicant respectfully traverses the rejection.

Independent claims 93 and 129 are described above.

Claims 94-98 and 100 depend from claim 93, and incorporate all of the subject matter of claim 93 and contain additional subject matter.

Claim 131 depends from claim 129, and incorporates all of the subject matter of claim 129 and contains additional subject matter.

Sizer and Krisbergh are characterized above.

Krueger et al. (U.S. patent number 6,460,075, issued October 1, 2002)

Krueger shows a browser-based email system having a thin client connected to a host mail server. Krueger et al. column 1, lines 65-66. The thin client implements a browser. Ibid., column 1, lines 66-67. The thin client is equipped with a microphone and video input to receive audio and video data which the thin client can capture for inclusion with email messages. Ibid., column 2, lines 5-10.

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The system further includes a set-top box having a television tuner and standard network interface devices to enable simultaneous viewing of both television programs and web programming. Ibid., column 2, line 65 – column 3, line 1.

In Krueger's system the clients and servers connect to the Internet via conventional means, such as direct-dial telephone or ISDN (Integrated Services Digital Network). Ibid., column 3, lines 13-15.

Nowhere does Krueger teach or suggest a message control interface constructed to control a message responsive to user input signals entered via a telephone, to which claims 93 and 129 are *inter alia* directed. In other words, nowhere does Krueger teach or suggest a system by which a user can use a telephone to select or otherwise control a message for display on a television associated with a terminal with a particular address.

Legal Analysis

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) must teach or suggest all the subject matter of the claim. M.P.E.P. §2142; *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

As shown in the analysis above, the combination of Sizer and Krisbergh fails to render obvious the subject matter of claims 93 and 129 because the prior art references when combined do not teach or suggest all of subject matter of the claims, as required by the M.P.E.P. §2142.

Further, as shown in the above factual and legal analyses, there would have been no motivation to combine Sizer and Krisbergh at the time the application was filed because such a combination would have required changing the principle of operation of either Sizer or Krisbergh.

Krueger does not cure the deficiencies of Sizer and Krisbergh because, like these two references, Krueger does not teach or suggest a message control interface constructed to control a message responsive to user input signals entered via a telephone, to which claims 93 and 129 are *inter alia* directed.

As Krueger does not correct the deficiencies of Sizer in combination with Krisbergh, therefore a *prima facie* case of obviousness has not been made.

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Claims 94-98 and 100 depend from claim 93, and incorporate all of the subject matter of claim 93 and contains additional subject matter. As the combination of Sizer, Krisbergh and Krueger fails to render obvious the subject matter of claim 93, therefore claims 94-98 and 100 also are not obvious in view of Sizer, Krisbergh and Krueger, alone or in combination.

Claim 131 depends from claim 129, and incorporates all of the subject matter of claim 129 and contains additional subject matter. As the combination of Sizer, Krisbergh and Krueger fails to render obvious the subject matter of claim 129, therefore claim 131 also is not obvious in view of Sizer, Krisbergh and Krueger, alone or in any combination.

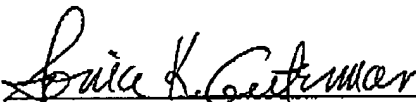
For any of the above reasons, Applicant respectfully requests withdrawal of rejection of claims 94-98, 100, and 131 under 35 U.S.C. §103(a).

Summary

On the basis of the foregoing reasons, Applicant respectfully submits that the pending claims are in condition for allowance, which is respectfully requested.

If there are any questions regarding these remarks, the Examiners are invited and encouraged to contact Applicant's representative at the telephone number provided.

Respectfully submitted,



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